Supreme Court, U.S.
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1996

PERRY W. GUINN, GARY N. MILLS,
ROBERT A. BEDIENT and MARTIN O. GREELEY,
Petitioners,

v.

HENRY B. KOPF,
Respondent.

Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

---

PETITION FOR A WRIT OF CERTIORARI

EDWARD S. IRONS
555 Thirteenth Street, N.W.
Suite 701—East Tower
Washington, D.C. 20004
Phone: (202) 626-3564
Attorney for Petitioner

WILSON - EPES PRINTING CO., INC. - 789-0096 - WASHINGTON, D.C. 20001

38 pp

QUESTIONS PRESENTED

1. Is 37 C.F.R. § 1.662(c) invalid under 35 U.S.C. § 6(a) because it is "inconsistent with" 35 U.S.C. § 253?

2. In an interference declared by the Commissioner of Patents and Trademarks between a patent and a pending application pursuant to 35 U.S.C. § 135(a)

> wherein all issues of priority of invention are mooted by the patentee's statutory disclaimer under 35 U.S.C. § 253 of all of the involved patent claims

does the Board of Patent Appeals and Interferences have jurisdiction after the disclaimer to enter a judgment that the patentee is not entitled to a patent containing the claim which he had already disclaimed?

3. In an interference declared pursuant to 35 U.S.C. § 135(a) by the Commissioner of Patents and Trademarks between a patent and a pending application

> wherein all issues of priority of invention are mooted by the patentee's statutory disclaimer under 35 U.S.C. § 253 of all of the involved patent claims and
>
> wherein no issues of patentability of the involved application claims have been fully developed on the record of the interference before the Board of Patent Appeals and Interferences,

does the board have jurisdiction to hold, in the absence of a record, that the patent applicant is entitled to a patent containing the involved application claims?

LIST OF ALL PARTIES TO THE PROCEEDING IN THE FEDERAL CIRCUIT

Petitioners Guinn, Mills, Bedient and Greeley, the patentees named on U.S. patent 4,889,812 involved in the proceeding before the Court of Appeals, are nominal parties. The real party petitioner in interest is UniSyn Technologies, Inc., 25 South Street, Hopkinton, Massachusetts 01748, assignee of that patent. As to UniSyn, there is no parent company or wholly owned subsidiary.

Respondent Kopf, an individual, was a party to the proceeding in the Court of Appeals.

The Commissioner of Patent and Trademarks was not a party to the proceeding in the Court of Appeals. The Commissioner filed a brief amicus curiae urging affirmance.

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---

PETITION FOR A WRIT OF CERTIORARI

Petitioners, Perry W Guinn, Gary N. Mills, Robert A. Bedient and Martin O. Greeley ("Guinn") respectfully petition this Court for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit in this case.

OPINIONS BELOW

The opinion of the Board of Patent Appeals and Interferences (App. 9a-14a) is not reported.

The opinion of the Court of Appeals for the Federal Circuit (App. 1a-8a) is reported at 96 F.3d 1419 (Fed. Cir. 1996).

JURISDICTION

The Order of the court of appeals denying a timely petition for reconsideration was filed November 12, 1996. This petition is timely under this Court's Rule 13.3.

The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1). The Court of Appeals had jurisdiction under 28 U.S.C. § 1295(a)(4)(A) (1994) and 35 U.S.C. § 141 (1994).

STATUTORY PROVISIONS, FEDERAL REGULATIONS AND TREATISE INVOLVED

Statutory Provisions:

35 U.S.C. § 6(a):

> (a) The Commissioner . . . may, subject to approval of the Secretary of Commerce, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office.

35 U.S.C. § 135(a) (1952):

> (a) Whenever an application is made for a patent, which in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The question of priority of invention shall be determined by a board of patent interferences. . . . A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent and Trademark Office.

35 U.S.C. § 135(a) (1994):

> (a) whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any

unexpired patent, an interference may be declared and the Commissioner shall give notice of such declaration to the applicants, or applicant and patentee, as the case may be. The Board of Patent Appeals and Interferences shall determine questions of priority of the inventions and may determine questions of patentability. . . .

35 U.S.C. § 253 (1952):

Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim. . . .

Federal Regulations:

37 C.F.R. § 1.601(f):

(f) A *count* defines the interfering subject matter between two or more applications or between one or more applications and one or more patents. . . . A claim of a patent or application that is designated to correspond to a count and is identical to that count is said to correspond exactly to the count. A claim of a patent or application that is designated to correspond to a count but is not identical to the count is said to correspond substantially to the count. . . . [emphasis in original]

37 C.F.R. § 1.601(i):

(i) An *interference* is a proceeding instituted in the Patent and Trademark Office before the Board to determine any question of patentability and priority of invention between two or more parties claiming the same patentable invention. . . . [emphasis in original]

37 C.F.R. § 1.601(n):

(n) Invention "A" is the *same patentable invention* as an invention "B" when invention "A" is the

same as (35 U.S.C. 102) or is obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A". Invention "A" is a *separate patentable invention* with respect to invention "B" when invention "A" is new (35 U.S.C. 102) and non-obvious (35 U.S.C. 103) in view of invention "B" assuming invention "B" is prior art with respect to invention "A". [emphasis in original]

37 CF.R. § 1.635:

A party seeking entry of an order relating to any matter other than a matter which may be raised under §1.633 or § 1.634 may file a motion requesting entry of the order. See § 1.637(a) and (b).

37 C.F.R. § 1.658:

. . . A judgment as to a count shall state whether or not each party is entitled to a patent containing the claims in the party's patent or application which correspond to the count. . . .

37 C.F.R. § 1.662(a) and (c):

(a) A party may, at any time during an interference, request and agree to entry of an adverse judgment. . . .

* * * *

(c) The filing of a statutory disclaimer under 35 U.S.C. 253 by a patentee will delete any statutorily disclaimed claims from being involved in the interference. A statutory disclaimer will not be treated as a request for entry of an adverse judgment against the patentee unless it results in the deletion of all patent claims corresponding to a count.

Treatise:

Rivise and Caeser *Interference Law and Practice,* (1947) Vol II, § 317, p. 1273:

> An interference may be terminated by dissolution on one or more of the following grounds:
>
> * * * *
>
> (3) In an interference involving an application and a patent, that the patentee has eliminated the conflicting subject matter by means of a reissue *or statutory disclaimer.*

Rivise and Caeser *Interference Law and Practice,* (1947) Vol. II, § 334, p. 1333:

> We have seen that a patentee involved in an interference may bring about a dissolution of the interference by filing a statutory disclaimer eliminating or substantially modifying the claims of his patent corresponding to the issue of the interference. . . .
>
> * * * *
>
> As has been stated, a patentee, who wishes to terminate an interference by disclaimer, has his choice between a statutory disclaimer and a disclaimer under Rule 107. *A statutory disclaimer is preferable, as it may result in a dissolution of the interference rather than in an adverse judgment.* [Emphasis added.]

STATEMENT OF THE CASE

This case involves Interference No. 103,096 declared by the Commissioner of Patents and Trademarks (Commissioner) pursuant to 35 U.S.C. § 135(a) between Guinn patent 4,889,812 (the '812 patent) and two pending applications of Kopf. The Commissioner summarily determined as a prerequisite to the redeclaration of Interference No. 103,096 that only claim 9 of the Guinn patent and thirty "corresponding" claims pending in the Kopf applications—albeit not identical to Guinn claim 9—are nevertheless for the "same patentable invention"—i.e., that each of the thirty Kopf application claims are limited to subject matter which would be "obvious", 35 U.S.C. § 103, and hence not patentable if Guinn's claim 9 were prior art. See 37 C.F.R. § 1.601(n).

Guinn filed a statutory disclaimer under 35 U.S.C. § 253 of his '812 patent claim 9—the only patent claim involved in the interference. The Board, instructed by 37 C.F.R. § 1.662(c), treated the Guinn disclaimer as a "request for entry of judgment". 37 C.F.R. § 1.658 required the judgment to state whether Kopf "is entitled to a patent containing the [30] claims in [Kopf's] applications which correspond to [but are not identical to Guinn claim 9]." The judgment entered by the Board states:

> For the foregoing reasons, judgment as to the subject matter of the sole count in issue is hereby awarded to Henry B. Kopf, the junior party.
>
> Accordingly, Henry B. Kopf is entitled to a patent containing his involved claims 19-31 in application Serial No. 07/442,240, and is also entitled to a patent containing his involved claims 20-38 in application Serial No. 07/207,655. . . . Perry W. Guinn, Gary N. Mills, Robert A. Bedient and Martin O Greeley, the senior party patentees, are not entitled to a patent containing their involved claim 9 which has been disclaimed under 35 U.S.C. 253. [App. 13a-14a]

The Court of Appeals affirmed "the Board's judgment" (App. 8a).

This case fundamentally challenges the Commissioner's scheme, spawned in 1984, to require that all interferences must be terminated only by a judgment—and not by dissolution or dismissal without a judgment. The validity of 37 C.F.R. § 1.662(c) and 37 C.F.R. § 1.658(a) which implement that scheme and which underpin both judgments is specifically challenged. Also challenged is the exercise of purported "jurisdiction" in the Board and the Court of Appeals to enter any priority "judgment" *after* all priority questions had been mooted by a statutory disclaimer under 35 U.S.C. § 253. Further challenged is the Board's power to enter any patentability "judgment" in favor of Kopf or any applicant party to an

interference in the absence of any patentability record developed before it to support such a "judgment".

I. EVOLUTION OF 37 C.F.R. §§ 1.662(c) AND 1.658(a)

35 U.S.C. § 135(a), in the 1952 Patent Act, limits the Board's jurisdiction to the determination of *only* "the question of priority" in an interference:

> (a) Whenever an application is made for a patent, which in the opinion of the Commissioner, would interfere with any pending application, or *with any unexpired patent,* he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. *The question of priority of invention shall be determined by a board of patent interferences.* . . . [emphasis added]

Under the 1952 Act, interferences involving an application and a patent were routinely *dissolved without a judgment* if the patentee filed a statutory disclaimer pursuant to 35 U.S.C. § 253 (1952) of the involved patent claim (count). This dissolution by disclaimer and without a judgment practice is set forth in the authoritative treatise Rivise and Caeser *Interference Law and Practice,* Vol. II, § 317:

> An interference may be terminated by dissolution on one or more of the following grounds:
>
> * * * *
>
> (3) In an interference involving an application and a patent, that the patentee has eliminated the conflicting subject matter by means of a reissue *or statutory disclaimer.*

and § 334:

> We have seen that a patentee involved in an interference may bring about a dissolution of the interference *by filing a statutory disclaimer eliminating* or substantially modifying the claims of his patent corresponding to the issue of the interference. . . .
>
> * * * *

> As has been stated, a patentee, who wishes to terminate an interference by disclaimer, has his choice between a statutory disclaimer and a disclaimer under Rule 107. *A statutory disclaimer is preferable, as it may result in a dissolution of the interference rather than in an adverse judgment.* [Emphasis added.]

In 1984, 35 U.S.C. § 135(a) was amended to supplement the Board's *mandatory* jurisdiction to determine the question of *priority* by adding *discretionary jurisdiction* to determine "questions of *patentability*".[1]

Section 135(a), as amended, states:

> (a) Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, an interference may be declared and the Commissioner shall give notice of such declaration to the applicants, or applicant and patentee, as the case may be. The Board of Patent Appeals and Interferences shall determine questions of priority of the inventions and MAY *determine questions of patentability*. . . . [emphasis added]

After the amendment, the Commissioner promulgated Rules 1.662(c) and 1.658, purportedly under 35 U.S.C. § 6, to *eliminate* the disclaimer-dissolution without a judgment practice routine under the 1952 Act.

37 C.F.R. § 1.662(c) provides:

> (c) The filing of a statutory disclaimer under 35 U.S.C. § 253 by a patentee will delete any statutorily disclaimed claims from being involved in the *interference. A statutory disclaimer will* NOT *be treated as a request for entry of an adverse judgment*

---

[1] This careful Congressional limitation to *discretionary* patentability determination accommodates situations where, *as here*, there is *no* record developed before the Board to support any informed patentability determination.

> *against the patentee* UNLESS *it results in the deletion of all patent claims corresponding to a count.* [emphasis added [2]]

37 C.F.R. § 1.658(a) requires that:

> *A judgment as to a count shall state whether or not claims in the party's patent or application which correspond to [i.e., are summarily said by the Commissioner to be for the "same patentable invention as"] the count.* [emphasis added; see 37 C.F.R. § 1.601(f)]

In this case the Board, deprived by 37 C.F.R. § 1.658 of its statutory *discretion* under 35 U.S.C. § 135(b) *not* to so do, entered a void judgment in the total absence of any supporting relevant record that Kopf is entitled to patents containing all of his thirty "correspond[ing]" claims.

II. PROCEEDINGS BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Guinn's counsel was cognizant of both the established pre-1984 dissolution by "disclaimer and without a judgment" practice under the 1952 Act *and* of the Commissioner's attempt by promulgation of 37 C.F.R. §§ 1.662(c) and 1.658 to abolish that practice. Because these rules seemed invalid, Guinn concurrently filed a statutory disclaimer under 35 U.S.C. § 253 of claim 9 which states: "This disclaimer is not a request for entry of an adverse judgment under 37 C.F.R. § 1.662" and a motion pursuant to 37 C.F.R. § 1.635 to dismiss the interference for lack of jurisdiction to determine priority. Guinn reasoned that the Board's "priority" jurisdiction was extinguished by the disclaimer which deleted the only involved patent claim 9 from the interference, i.e., there was no longer any question of priority for the Board to determine.

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[2] Rule 1.662(c) appears to be an oxymoron. Its second sentence requires entry of a priority judgment as to the same claim which the first sentence of the rule says is "deleted . . . from being involved in the interference" by the disclaimer.

Instead of deciding the motion to dismiss, the Board ordered Guinn, in view of the statutory disclaimer of his patent claim 9, to "show cause" why judgment should not be entered against him as required by 37 C.F.R. §§ 1.662(c) and 1.658.

To discharge the show cause order, Guinn reasserted the reasons stated in support of the motion to dismiss.

The Board's final decision states:

> under the new rules, all interferences are required to be terminated with a judgment rather than merely being dissolved. 49 Fed. Reg. 48416, *supra*, at 48419.
>
> We are bound by the rules of practice and, in particular, § 1.662(c). *Cf. Myers v. Feigelman*, 455 F.2d 596, 172 USPQ 580 (CCPA 1972). There is no question that the rule requires entry of judgment against Guinn here in view of the filing of a statutory disclaimer of Guinn's sole involved claim.

III. PROCEEDINGS BEFORE THE COURT OF APPEALS

Guinn argued below, as he had before the Board, that the jurisdiction of the Board under 35 U.S.C. § 135(a) to determine "priority" was extinguished because claim 9, the sole count, was *deleted* from the interference by Guinn's statutory disclaimer *before* the judgment was entered. Accordingly, there was no "application which would interfere . . . with an unexpired patent", 35 U.S.C. § 135(a), because there was no question of "priority . . . between two or more parties claiming the same patentable invention" as required by 37 C.F.R. § 1.601(i) for the Board to determine. Guinn also urged that the Board's discretion under 35 U.S.C. § 135(a) to determine any question of patentability as to any of Kopf's thirty involved claims could not be exercised for want of any patentability record developed before it.

To demonstrate invalidity of 37 C.F.R. § 1.662(c) under 35 U.S.C. § 6, Guinn's brief demonstrated that 37 C.F.R. § 1662(c) imposes on 35 U.S.C. § 253 a "requirement for entry of judgment" limitation which Congress did not include.

IV. THE FEDERAL CIRCUIT DECISION

To find that the Board had subject matter jurisdiction to determine priority notwithstanding the disclaimer, the Federal Circuit opinion says that

> The language of the statute itself militates against the interpretation that disclaiming all claims relating to a single count in an interference divests the Board of jurisdiction over an interference. Section 135 provides the basis for the Commissioner to declare an interference. Guinn does not dispute that Interference 103,096 was properly declared by the Commissioner. Section 135 also states that the Board "shall determine questions of priority" after the declaration of an interference. Guinn asserts that his unilateral act of disclaiming claim 9 of the '812 patent can divest the Board of its responsibility to determine the priority question in the interference. The statute does not provide for any such divestment of jurisdiction.
>
> We have previously stated that priority issues that have been fully developed before the Board should be resolved by the Board [quoting *Perkins v. Kwon*, 886 F.2d at 328-29 [3]]. [6a]

To hold that Rule 1.662(c) is *not in*valid because it does *not* "place[] a qualification that is not within the purview of 35 U.S.C. § 253 on the *right of a patentee to*

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[3] *Perkins* is not relevant because no "priority issues [had] been fully developed before the Board." Instead, all priority issues were mooted by the disclaimer.

statutorily disclaim subject matter" [4] (7a; emphasis added), the opinion states:

> Rule 1.662(c) as promulgated by the Commissioner simply allows the Board to dispose of an interference as to the patentee who disclaims all claims involved in an interference.

REASONS WHY THE WRIT SHOULD BE GRANTED

The Court of Appeals for the Federal Circuit has held that 37 C.F.R. § 1.662(c) is *not invalid* under 35 U.S.C. § 6 because it is "consistent with [Guinn's] right to disclaim under . . . 35 U.S.C. § 253" (8a). That ruling is simply wrong. It is contradicted by a mere reading of the Patent Office rule and the statute. This surprising Federal Circuit decision is the more egregious because Rule 1.662(c), as applied, has resulted in a frivolous "judgment" by the Board and affirmed below

(1) that a *patentee* party to an interference is not entitled to a patent containing a claim which was deleted from the interference by statutory disclaimer *before* the *"judgment"* was entered (see Question 2), and

(2) that a patent *applicant* party to an interference, even if no patentability issues have been developed on the interference record, is entitled to a patent containing a plurality of involved claims which are not identical to the claim which was disclaimed by the patentee (see Question 3).

For more than a decade before the 1952 Patent Act, interferences between an unexpired patent and a pending

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[4] To the contrary, § 253 does *not* provide a patentee a right "to disclaim *subject matter*"—§ 253 authorizes disclaimer only of "any complete claim" of a patent.

This escalation of § 253 by the court is the predicate for its several further attempts elsewhere in the opinion to escalate Guinn's "disclaimer of all claims involved in the interference"—i.e., not only of claim 9, but also of the thirty "involved" claims in Kopf's applications. *See* note 5, *infra*, p. 13.

application were terminated by dissolution and of necessity without a judgment upon patentee's disclaimer under 35 U.S.C. § 253 of all of the involved patent claims, which mooted all priority issues leaving nothing for the Board to adjudicate.

The Commissioner of Patents and Trademarks disfavored this practice. In 1984, the Commissioner promulgated new rules, in particular 37 C.F.R. § 1.662(c) and § 1.658, to abolish it. It was the intent of those rules, and they have been so applied in this case, to preclude any termination of an interference without a judgment. Instead, all interferences *must* be terminated *only* by a judgment.

The Federal Circuit strains to sustain Rule 1.662(c) in the face of its manifest clash with a patentee's unqualified statutory right under 35 U.S.C. § 253 to disclaim a specific claim from an issued patent. The flawed centerpiece of the Court's opinion is an unacknowledged and undocumented, but frequently repeated, implication that Guinn, by exercising his statutory right to disclaim his patent claim 9, *also* "disclaimed" 30 claims—all different from Guinn's patent claim 9—pending in two Kopf's patent applications.[5]

The Court's decision is wrong and its judgment is void virtually on its face and for all of the reasons now set

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[5] For example, at the threshold of its opinion, the Court refers to Guinn's "two attacks" on "the validity of Rule 1.662(c) as it concerns an entry of adverse judgment against a patentee who disclaims all claims corresponding to a count in an interference" (4a). This statement mischaracterizes the record. Without so stating, the Court's expression "all claims" includes and is intended to include *not only* Guinn's patent claim 9, which was disclaimed, *but also* Kopf's 30 "corresponding" claims. Contrary to the Board's statement, Guinn's statutory disclaimer was necessarily limited to his patent *claim 9, alone.* It did *not* and indeed could not extend to claims *only* in Kopf's applications, none of which are identical to Guinn's claim 9.

forth, which compel an affirmative answer to Question 1 and negative answers to Questions 2 and 3.

Guinn's brief below demonstrates:

> that 37 C.F.R. § 1.662(c) is "inconsistent with law", 35 U.S.C. § 6, because it
>
> > imposes a *limitation* upon 35 U.S.C. § 253 as evidenced by the following reproduction of that statute with the imposed limitation italicized:
> >
> > > . . . A patentee . . . may, on payment of the fee required by law, make disclaimer of any complete claim, . . . [*provided, however, if the patentee is involved in an interference, the disclaimer shall constitute a request for adverse judgment if it results in the deletion of all patent claims corresponding to the count*].
> >
> > Congress included no such limitation on 35 U.S.C. § 253 and, by 35 U.S.C. § 6, precluded the Commissioner from doing so by rule. [pp. 17-18]

The Federal Circuit's opinion ignores this demonstration that Rule 1.662(c) is invalid, with concomitant disregard of this Court's admonition that:

"*We have . . . cautioned that courts 'should not read into the patent laws limitations and conditions which the legislature has not expressed.' United States v. Dubilier Condenser Corp.*, 289 U.S. 178, 199, 53 S.Ct. 554, 561, 77 L.Ed. 1114 (1933)." [Emphasis added.] *Diamond v. Chakrabarty*, 447 U.S. 303, 308, 100 S.Ct. 2204, 2207 (1980).

The opinion's feeble rejoinder (taken from the Commissioner's *amicus* brief) that "Rule 1.662(c) as promulgated by the Commissioner *simply allows* the Board to dispose of an interference as to the patentee who disclaims *all claims* involved in an interference" (emphasis added) (7a) is clearly wrong. It is contradicted by the fact, among others, that Rule 1.662(c) imposes limita-

tions on the disclaimer statute which are not acknowledged by the Court's statement.

In the statement quoted from the opinion, the expression "all claims involved in an interference" (7a) means not only such claims as may have been specifically disclaimed under 35 U.S.C. § 253 from a patentee's own patent, but "all claims" of an adverse party's application which are different from but nevertheless designated by the Commissioner to "correspond" to the patentee's disclaimed claim. See note 5, *supra*. In the context of this interference, the expression "all claims" means not only Guinn's patent claim 9, as to which his statutory right to disclaim was specifically exercised, but also Kopf's 30 "corresponding" application claims, all of which are different from Guinn's claim 9. This Court's statement is not relevant to this interference because Guinn did not disclaim "all claims"—but only claim 9 of his patent.

Citing *Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp.*, 294 U.S. 477, 492 (1935), the opinion states that "by filing a statutory disclaimer, Guinn relinquished any right to exclude others from the subject matter of claim 9" (7a). Contrary to the inference which this statement may invite, however, Guinn did *not* by filing the disclaimer relinquish any right whatever with respect to the "subject matter" of any of Kopf's 30 pending claims which are different from claim 9.

The Court's opinion goes on to state: "Rule 1.662(c) clearly calls for entry of judgment only *against the patentee* who disclaimed the involved claims, and through his own admission is not entitled to the disclaimed claim, and nothing more" (7a-8a) (emphasis in original). This statement is incorrect for several reasons:

(1) Guinn did not disclaim the 30 Kopf claims "involved" in the interference, but only and specifically claim 9 of his patent "and nothing more".

(2) The judgment amended by 37 C.F.R. § 1662(c) must comply with § 1.658 and, therefore, include a determination of whether Kopf is entitled to a patent containing his 30 corresponding claims which are different from Guinn's cancelled claim 9.

Thus, the statement that the judgment is "only *against the patentee*" (8a; emphasis in original) tends to create an erroneous impression that Guinn suffered no adverse consequences from the entry of the judgment beyond those consequent from the disclaimer. To the contrary, however, Guinn and the public must now await the grant to Kopf of a patent which contains the 30 "involved" application claims—all in derogation of "the PTO's mission to grant presumptively valid patents. 35 U.S.C. § 285 . . .". *Perkins*, 886 F.2d at 328-9.

The opinion then states:

> Rule 1.662(c) does not address the question of the patentability of a claim or claims corresponding to a count to the party or parties of the interference who have not so disclaimed all of the involved claims. (8a)

This statement is also incorrect, however, because the "judgment", entry of which Rule 1.662(c) mandates, must include a determination of the question of patentability of the "claim or claims corresponding to a count which the party or parties of the interference . . . have not so disclaimed"—here Kopf's 30 application claims (8a). And again the implication that Guinn disclaimed "all of the involved claims" (8a) is simply wrong for reasons stated above.

Based on these erroneous premises, the opinion states: "Therefore, the entry of a judgment against Guinn in the interference is proper and consistent with his right to disclaim under 35 U.S.C. § 253" (8a)—i.e., that Rule 1.662(c) is "not inconsistent with § 253". This ruling is wrong because the premises upon which it is based have

been shown to be wrong. In particular, Guinn's "right to disclaim under 35 U.S.C. § 253" is *un*qualified. It is not conditioned upon an implied "disclaimer" of Kopf's 30 involved application claims.

Finally, the opinion states that: "The patentability of Kopf's claims corresponding to the count is beyond the scope of this appeal" (8a). Actually, this statement is just a cover up for the Court's evasion of its obligation to adjudicate the key question which *was* squarely presented by the appeal, namely, whether—for lack of any patentability record developed before it—so much of the judgment as states that Kopf is entitled to a patent containing the 30 corresponding claims is void. Indeed, the very fact that the patentability of Kopf's 30 claims was "beyond the scope of this appeal" (8a) is the direct consequence of the lack of any patentability record and therefore of any determination of any patentability question by the Board.

CONCLUSION

The incorrect decision of the Federal Circuit will control the practice in every interference now pending or later declared between an unexpired patent and a pending application. There is no possibility that the matter will be further reviewed by the Court of Appeals because the panel decision was maintained on reconsideration. Grant of this Petition is essentially to rectify the interference procedures in the Patent Office.

Respectfully submitted,

EDWARD S. IRONS
555 Thirteenth Street, N.W.
Suite 701—East Tower
Washington, D.C. 20004
Phone: (202) 626-3564
Attorney for Petitioner

APPENDICES

APPENDICES

APPENDIX A

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

96-1098
(Interference No. 103,096)

PERRY W. GUINN, GARY N. MILLS, ROBERT A. BEDIENT and MARTIN O. GREELEY,
Appellants,

v.

HENRY B. KOPF,
Appellee.

Appealed from Trademark Office
Board of Patent Appeals and Interferences

DECIDED: September 26, 1996

Before RICH, NEWMAN, and BRYSON, *Circuit Judges.*

RICH, *Circuit Judge.*

Perry W. Guinn, Gary N. Mills, Robert A. Bedient, and Martin O. Greeley (collectively Guinn) appeal the judgment of the Board of Patent Appeals and Interferences (Board) mailed on November 29, 1994 in Patent Interference No. 103,096, wherein the sole count in issue in the interference was awarded to appellee Kopf, and the Board held that Kopf was entitled to a patent containing claims 19-31 in application Serial No. 07/442,240, and

a patent containing claims 20-38 in application Serial No. 07/207,655, with the proviso that Kopf avoid a double patenting rejection upon resumption of prosecution upon termination of the interference.[1] We have jurisdiction under 38 [sic 28] U.S.C. § /1295(a)(4)(A) (1994) and 35 U.S.C. § 141 (1994) to review this appeal from the final decision of the Board. We affirm.

Background

On September 29, 1994, Interference No. 103,096 was redeclared by the United States Patent and Trademark Office (PTO) between United States Patent No. 4,889,812 ('812 patent) issued to Guinn and two patent applications of Kopf with Serial Nos. 07/442,240 ('240 patent application) and 07/207,655 ('655 patent application). The redeclared interference contained a single count corresponding to claim 9 of the '812 patent, claims 19-31 of the '240 patent application, and claims 20-38 of the '655 patent application.

On October 13, 1994, Guinn attempted to terminate the interference by filing a statutory disclaimer under 35 U.S.C. § 253 of claim 9, the only claim of the '812 patent corresponding to the single count of the interference, and a concurrent motion pursuant to 37 C.F.R. § 1.635 to dismiss the interference for lack of jurisdiction. Guinn asserted that as a result of the disclaimer of claim 9, no claim which corresponded to the single count of the interference remained in the '812 patent so that no controversy existed between the parties. Therefore, Guinn reasoned that the Board had no jurisdiction to enter a judgment and should have dismissed the interference. To this end, Guinn specifically stated in the statutory dis-

---

[1] Guinn also seeks to appeal the denial of a petition to the Commissioner pursuant to 37 C.F.R. § 1.644(a)(1) and (2). We need not determine whether we have jurisdiction over an appeal from the denial of such a petition because the same issues were presented to and decided by the Board.

claimer that: "This disclaimer is not a request for entry of an adverse judgment under 37 C.F.R. § 1.662."

In response to the motion to dismiss filed by Guinn, on November 1, 1994 the Board issued an order to show cause why judgment should not be entered against Guinn as a result of the statutory disclaimer. The Board stated that even though Guinn specifically asserted in his statutory disclaimer that it was not a request for entry of an adverse judgment, "[p]ursuant to 37 CFR 1.662(c), the statutory disclaimer will be treated as a request for entry of an adverse judgment against Guinn et al."

Guinn filed a response to the order to show cause reasserting the argument that 37 C.F.R. § 1.662(c) was invalid as a matter of law because the Board lacked jurisdiction to enter judgment against Guinn because Guinn was no longer "claiming the same patentable invention" as required by 35 U.S.C. § 135(a) with the advent of the disclaimer of claim 9 of the '812 patent. On November 14, 1994, Kopf filed a response to Guinn's response to the order to show cause asserting that the Commissioner had the authority under the broad jurisdiction over patent matters granted to him by Congress in 35 U.S.C. § 6 to promulgate 37 C.F.R. § 1.662(c). Kopf argued that by disclaiming under 35 U.S.C. § 253 the only claim involved in the interference, Guinn conceded that the invention was unpatentable to him and that adverse judgment was appropriate as called for by 37 C.F.R. § 1.662(c).

The Board issued its final decision on November 29, 1994 entering a judgment as to the sole count in issue in the interference to appellee Kopf, and awarding a patent containing claims 19-31 of the '240 patent application to Kopf, and a patent containing claims 20-38 of the '655 patent application to Kopf, with the proviso that Kopf avoid the double patenting rejection upon resumption of prosecution upon termination of the interference.

On December 9, 1994, Guinn filed a petition pursuant to 37 C.F.R. § 1.644(a)(1) and (2) requesting that the

judgment of the Board be vacated, that 37 C.F.R. § 1.662(c) be declared invalid and void because it is "inconsistent with law" and exceeds the power vested in the Commissioner under 35 U.S.C. §§ 6 and 7, and that the judgment be vacated because at the time it was entered, no actual controversy existed between the parties and the Board had no jurisdiction. Kopf responded by arguing again that the Commissioner properly promulgated 37 C.F.R. § 1.662(c) under 35 U.S.C. §§ 6 and 7 providing the Board with valid jurisdiction to enter adverse judgment against Guinn in the interference. On January 23, 1995 the Board denied the petition ruling that 37 C.F.R. § 1.662(c) is not inconsistent with 35 U.S.C. § 253 and was within the scope of the Commissioner's authority to establish regulations for the conduct of proceedings within the PTO under 35 U.S.C. § 6.

Discussion

The single issue we must decide is whether the Commissioner properly promulgated 37 C.F.R. § 1.662(c) (Rule 1.662(c)) under the authority granted by Congress under 35 U.S.C. § 6. Rule 1.662(c) provides:

> The filing of a statutory disclaimer under 35 U.S.C. 253 by a patentee will delete any statutorily disclaimed claims from being involved in the interference. *A statutory disclaimer will not be treated as a request for entry of an adverse judgment against the patentee unless it results in the deletion of all patent claims corresponding to a count.*

37 C.F.R. § 1.662(c) (1995) (emphasis added).

Appellant offers two attacks on the validity of Rule 1.662(c) as it concerns an entry of adverse judgment against a patentee who disclaims all claims corresponding to a count in an interference. First, Guinn asserts that the judgment entered by the Board against him pursuant to Rule 1.662(c) is void because Guinn's statutory dis-

claimer of the only claim involved in the interference count extinguished any subject matter jurisdiction of the Board under 35 U.S.C. § 135, and is thus a rule promulgated by the Commissioner that is inconsistent with law in contradiction to his authority under 35 U.S.C. § 6. Second, Guinn argues that Rule 1.662(c) is inconsistent with the law regarding statutory disclaimers, 35 U.S.C. § 253, because Rule 1.662(c) imposes a limitation on a patentee's right to disclaim that is not provided in 35 U.S.C. § 253. Both of these attacks on the validity of Rule 1.662(c) involve statutory interpretation only. Therefore, they are questions of law which we review de novo. *Astra* v. *Lehman*, 71 F.3d 1578, 1580, 37 USPQ2d 1212, 1214 (Fed. Cir. 1995).

I. *The Board's Subject Matter Jurisdiction*

Congress has provided that the Commissioner "may . . . establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office." 35 U.S.C. § 6(a)(1994). Congress has also provided that:

> Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, an interference may be declared and the Commissioner shall give notice of such declaration to the applicants, or applicant and patentee, as the case may be. The Board of Patent Appeals and Interferences shall determine questions of priority of the inventions and may determine questions of patentability.

Pursuant to 35 U.S.C. §135, Interference 103,096 was redeclared. Appellant does not assert that such declaration was erroneous. Appellant asserts that because he availed himself of 35 U.S.C. § 253 to disclaim the only claim of his patent corresponding to the interference count, the interference should have been dismissed with

no adverse judgment against him because the Board had no jurisdiction over the interference as defined by 35 U.S.C. §135 to enter such an adverse judgment.

The language of the statute itself militates against the interpretation that disclaiming all claims relating to a single count in an interference divests the Board of jurisdiction over an interference. Section 135 provides the basis for the Commissioner to declare an interference. Guinn does not dispute that Interference 103,096 was properly declared by the Commissioner. Section 135 also states that the Board "shall determine questions of priority" after the declaration of an interference. Guinn asserts that his unilateral act of disclaiming claim 9 from the '812 patent can divest the Board of its responsibility to determine the priority question in the interference. The statute does not provide for any such divestment of jurisdiction.

We have previously stated that priority issues that have been fully developed before the Board should be resolved by the Board.

> The Board, by resolving both priority and patentability when these questions are fully presented, settles not only the rights between the parties, but also rights of concern to the public. The public interest in the benefits of a patent system is best met by procedures that resolve administratively questions affecting patent validity that arise before the PTO. To do otherwise is contrary to the PTO's mission to grant presumptively valid patents, 35 U.S.C. § 285, and thus disserves the public interest.

Perkins v. *Kwon*, 886 F.2d 325, 328-29, 12 USPQ2d 1308, 1311 (Fed. Cir. 1989).

We hold that the Board had the authority and the responsibility pursuant to 35 U.S.C. § 135(a) to resolve the interference and render judgment against Guinn as a result of his disclaimer of claim 9 of the '812 patent.

II. *Authority of the Commissioner under 35 U.S.C. § 6*

The second issue before us in the determination of whether Rule 1.662(c) is valid is whether the rule as promulgated by the Commissioner places a qualification that is not within the purview of 35 U.S.C. § 253 on the right of a patentee to statutorily disclaim subject matter. If such an unauthorized qualification is imposed by Rule 1.662(c), it is inconsistent with law and outside the authority granted to the Commissioner under 35 U.S.C. § 6.

To aid in the disposition of interferences, the Commissioner, pursuant to 35 U.S.C. § 6(a), promulgated 37 C.F.R. § 1.662(c). The right of a patentee to statutorily disclaim a claim or claims is provided in 35 U.S.C. § 253, which states that:

> A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent.

35 U.S.C. § 253 (1994).

A statutory disclaimer under 35 U.S.C. § 253 has the effect of canceling the claims from the patent and the patent is viewed as though the disclaimed claims had never existed in the patent. *See Altoona Publix Theatres, Inc.* v. *American Tri-Ergon Corp.*, 294 U.S. 477, 492 (1935) ("Upon the filing of the disclaimers, the original claims were withdrawn from the protection of the patent laws, and the public was entitled to manufacture and use the device originally claimed as freely as though it had been abandoned."). Therefore, by filing a statutory disclaimer, Guinn relinquished any right to exclude others from the subject matter of claim 9.

Rule 1.662(c) as promulgated by the Commissioner simply allows the Board to dispose of an interference as to the patentee who disclaims all claims involved in an interference. Rule 1.662(c) clearly calls for entry of

judgment only *against the patentee* who disclaimed the involved claims, and through his own admission is not entitled to the disclaimed claim, and nothing more. Rule 1.662(c) does not address the question of the patentability of a claim or claims corresponding to a count to the party or parties of the interference who have not so disclaimed all of the involved claims. Therefore, the entry of a judgment against Guinn in the interference is proper and consistent with his right to disclaim under 35 U.S.C. § 253. The patentability of Kopf's claims corresponding to the count is beyond the scope of this appeal. We hold that rule 1.662(c) as promulgated by the Commissioner under 35 U.S.C. § 6(a) is valid.

Conclusion

We affirm the Board's judgment of November 29, 1994 in Patent Interference No. 103,096, against Guinn.

AFFIRMED

APPENDIX B

[Mailed Nov. 29, 1994]
Paper No. 48

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

HENRY B. KOPF,
Junior Party [1]

v.

HENRY B. KOPF,
Junior Party [2]

v.

PERRY W. GUINN, GARY N. MILLS, ROBERT A. BEDIENT and MARTIN O. GREELEY,
Senior Party [3]

Patent Interference No. 103,096

---

[1] Application of 07/442,240, filed November 28, 1989. Accorded the benefit of U.S. Application 06/936,486, filed November 26, 1986, now U.S. Patent No. 4,885,087, issued December 5, 1989.

[2] Application 07/207,655, filed June 21, 1988. Accorded the benefit of U.S. Application 06/936,486, filed November 26, 1986, now U.S. Patent No. 4,885,087, issued December 5, 1989.

[3] Patent 4,889,812, issued December 26, 1989, based on U.S. Application 06/862,014, filed May 12, 1986. Assignors to UniSyn Technologies, Inc.

Before SOFOCLEOUS, CAROFF and DOWNEY, *Administrative Patent Judges.*

CAROFF, *Administrative Patent Judge.*

FINAL DECISION

This interference involves two applications of the junior party, Kopf, and a patent of the senior party, Guinn et al (Guinn). According to the record before us, the Guinn patent is assigned to UniSyn Technologies, Inc. (Paper No. 4); whereas each of the two Kopf applications is unassigned.

The subject matter of the interference relates to an apparatus for circulating fluid through a shell and tube type bioreactor. This invention is particularly defined by the sole count[4] in issue which reads as follows:

Count 2

An apparatus for cultural microbial species, comprising:

a nutrient source;

a 4-way switchable valve comprising first, second, third and fourth fluid ports switchable between (i) a first position wherein the first and second fluid ports are in flow communication with one another, and the third and fourth fluid ports are in flow communication with one another, and (ii) a second position wherein the first and fourth fluid ports are in flow communication with one another, and the second and third fluid ports are in flow communication with one another;

a shell and tube type bioreactor having first and second ends communicating with bioreactor lumen tubes for flow of fluid medium therethrough; and

---

[4] Original count 1 was canceled and count 2 added by redeclaration (Paper No. 32).

> flow circuit means interconnecting the nutrient source, the 4-way switchable valve, and the shell and tube type bioreactor, such that when the 4-way switchable valve is in the first position, the flow through the bioreactor lumen tubes is in a first flow direction, and when the 4-way switchable valve is in the second position, the flow through the bioreactor lumen tubes is in a second flow direction.

The claims of the parties which correspond to count 2 are:

Kopf (Serial No. 07/442,240):	Claims 19-31
Kopf (Serial No. 07/207,655):	Claims 20-38
Guinn et al.:	Claim 9

On October 13, 1994, Guinn filed a statutory disclaimer of its sole involved claim (claim 9). Accordingly, the Administrative Patent Judge (APJ) issued an order to show cause against Guinn (Paper No. 43), indicating that the statutory disclaimer will be treated as a request for entry of an adverse judgment against Guinn pursuant to 37 CFR 1.662(c). Guinn has filed a response to the order to show cause (Paper No. 45), and Kopf has filed a response to that of Guinn (Paper No. 46).

In their respective responses, neither party has requested that a final hearing or a testimony period be set with respect to the propriety of the show cause order. Rather, the Guinn response contains a discussion of reasons why Guinn believes that the rule, § 1.662(c), is "facially invalid" and that the Board therefore lacks jurisdiction to enter judgment against Guinn in view of Guinn's filing of a statutory disclaimer.

As set forth in the Commissioner's Notice entitled "*Interference Practice: Response to Order to Show Cause under 37 CFR 1.640,*" 1074 O.G. 4 (Jan. 6, 1987),

where the response does not request a final hearing or a testimony period but, instead, contains a full discussion of the reasons why judgment should not be entered, the response paper is deemed to waive "any opportunity to present oral argument concerning the matters discussed therein, and the matter will be decided by the Board based upon the content of the paper and any response thereto." *Qadri v. Chu*, 18 USPQ2d 1254 (BPAI 1990), *aff'd. mem.*, 965 F.2d 1063 (Fed. Cir. 1992); *Brown v. Bravet*, 25 USPQ2d 1147 (BPAI 1992). Accordingly, we will decide the matter discussed by the parties in their respective responses based upon the arguments presented therein.

We have carefully considered the papers filed in response to the order to show cause and find that entry of judgment against Guinn is appropriate essentially for the reasons presented by Kopf. Indeed, judgment is mandatory according to the commentary accompanying the adoption of the present interference rules as follows:

> Several comments discussing [§] 1.662 were received. Two comments suggested a change be made to provide that when a patentee files a statutory disclaimer under 35 U.S.C. 253 and deletes all claims corresponding to a count, the disclaimer will be treated as a request for judgment. As one of the comments pointed out, "[s]ince . . . [the filing of a statutory disclaimer disclaiming all claims corresponding to a count] by the patentee could have no other conceivable effect, the proposed rule should be changed to require judgment when all corresponding claims are disclaimed." The suggestion has been adopted and appropriate changes have been made to [§] 1.662(c).
>
> —49 Fed. Reg. 48416, 48447 (Dec. 12, 1984)

Further, under the new rules, all interferences are required to be terminated with a judgment rather than

merely being dissolved. 49 Fed. Reg. 48416, *supra*, at 48419.

We are bound by the rules of practice and, in particular, § 1.662(c). *Cf. Myers v. Feigelman*, 455 F.2d 596, 172 USPQ 580 (CCPA 1972). There is no question that the rule requires entry of judgment against Guinn here in view of the filing of a statutory disclaimer of Guinn's sole involved claim.

Guinn's argument relating to the authority of the Commissioner to promulgate § 1.662(c) and the validity of that rule is unsound. There is no question that this interference was properly declared, and that the Board thereby acquired jurisdiction over the interference. 37 CFR 1.614. Guinn has cited no authority to support its position which would in effect give a party the power to deprive the Board of jurisdiction, once acquired, by taking unilateral action. Indeed, it is well settled that a party may not avoid judgment as to claims corresponding to a count by, for example, amending or canceling those claims. *Cf.* Rivise and Caesar, *Interference Law and Practice*, Vol. II, Michie Co., 1947, § 317 (p. 1274), § 333 (pp. 1332-33).

Judgment [5]

For the foregoing reasons, judgment as to the subject matter of the sole count in issue is hereby awarded to Henry B. Kopf, the junior party.

Accordingly, Henry B. Kopf is entitled to a patent containing his involved claims 19-31 in application Serial

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[5] It is noted that Kopf filed a § 1.635 motion on Nov. 14, 1994 (Paper No. 47) requesting suspension of the testimony period set in Paper No. 33. The motion is unopposed and is considered to be moot in view of the judgment entered herein. However, in view of the possibility that Guinn may file an appeal or petition regarding our decision, the motion to suspend the previously set testimony and briefing period is *granted* pending the outcome of any such appeal or petition.

No. 07/442,240, and is also entitled to a patent containing his involved claims 20-38 in application Serial No. 07/207,655, provided that Kopf takes the action which is necessary to avoid a double patenting rejection, *e.g.*, by filing a terminal disclaimer in one of his involved applications, when *ex parte* prosecution resumes upon termination of this interference. Perry W. Guinn, Gary N. Mills, Robert A. Bedient and Martin O. Greeley, the senior party patentees, are not entitled to a patent containing their involved claim 9 which has been disclaimed under 35 U.S.C. 253.

BOARD OF PATENT APPEALS
AND INTERFERENCES

/s/ Michael Sofocleous
MICHAEL SOFOCLEOUS
Administrative Patent Judge

/s/ Marc L. Caroff
MARC L. CAROFF
Administrative Patent Judge

/s/ Mary F. Downey
MARY F. DOWNEY
Administrative Patent Judge

APPENDIX C

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

96-1098
(Interference No. 103,096)

PERRY W. GUINN, GARY N. MILLS,
ROBERT A. BEDIENT and MARTIN O. GREELEY,
Appellants,

v.

HENRY B. KOPF,
Appellee.

ORDER

A combined petition for rehearing and suggestion for rehearing in banc having been filed by the APPELLANT, and the petition for rehearing having been referred to the panel that heard the appeal, and thereafter the suggestion for rehearing in banc having been referred to the circuit judges who are in regular active service,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same hereby is, DENIED and it is further

ORDERED that the suggestion for rehearing in banc be, and the same hereby is, DECLINED.

The mandate of the court will issue on November 19, 1996.

FOR THE COURT,
MELVIN L. HALPERN
Acting Clerk

Dated: November 12, 1996

By /s/ Brian P. LeDuc
BRIAN P. LEDUC
Associate Chief Deputy Clerk

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No. 96-1271

In The

Supreme Court of the United States

October Term, 1996

PERRY W. GUINN, GARY N. MILLS,
ROBERT A. BEDIENT and MARTIN O. GREELEY,

Petitioners,

vs.

HENRY B. KOPF,

Respondent.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

RESPONDENT'S BRIEF IN OPPOSITION

STEVEN J. HULTQUIST
Counsel of Record

INTELLECTUAL PROPERTY/
TECHNOLOGY LAW
200 Park Offices Drive, Suite 210
Research Triangle Park, NC 27709
Telephone: (919) 990-9531
Attorney for Respondent,
Henry B. Kopf

COCKLE LAW BRIEF PRINTING CO., (800) 225-6964
OR CALL COLLECT (402) 342-2831

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Appendix B – October 9, 1992 Communication from Supervisory Primary Examiner James C. Housel of Group 180 of U.S. Patent and Trademark Office in U.S. Patent Application No. 07/207,665 of Henry B. Kopf (Paper No. 10) .....App. 3

RESPONDENT'S BRIEF IN OPPOSITION

Respondent Henry B. Kopf requests that the Court deny the Petition for Writ of Certiorari seeking review of the judgment of the United States Court of Appeals for the Federal Circuit. The opinion of the Court of Appeals for the Federal Circuit is reported at 96 F.3d 1419 (Fed. Cir. 1996).

STATEMENT OF THE CASE

Interference No. 103,096 was declared by the United States Patent and Trademark Office ("PTO") on February 16, 1993, between two pending United States patent applications of Henry B. Kopf ("Respondent"), both of which have been accorded the benefit of a filing date of November 26, 1986, and an issued United States patent of Perry W. Guinn, et al., ("Petitioners"), which has an effective filing date of May 12, 1986. Claims 19-31 and 20-38, respectively, of the two Kopf applications and claim 9 of the Guinn et al. patent were designated as corresponding to the sole "count" of the interference (defining the inventive subject matter claimed by both parties). Both the Kopf applications and the Guinn, et al., patent relate to bioreactor apparatus systems.

On October 13, 1994, Guinn, et al., filed a disclaimer under 35 U.S.C. § 253 of claim 9 of the patent, the only claim corresponding to the count, together with a motion to dismiss the interference for lack of jurisdiction. The disclaimer included a statement that "[t]his disclaimer is not a request for entry of an adverse judgment under 37 C.F.R. § 1.662," contrary to part (c) of 37 C.F.R. § 1.662, which provides (emphasis added):

> The filing of a statutory disclaimer under 35 U.S.C. § 253 by a patentee will delete any statutorily disclaimed claims from being involved in the interference. A statutory disclaimer will not be treated as a request for entry of an adverse judgment against the patentee *unless it results in the deletion of all patent claims corresponding to a count.*

Guinn, et al., timely filed a response to an order to show cause on November 4, 1994, contending that the Board had no jurisdiction to enter judgment, and that 37 C.F.R. § 1.662(c) was invalid. The Board held that Kopf was entitled to priority and issuance of patents on his applications involved in the interference. The United States Court of Appeals for the Federal Circuit affirmed the decision of the Board, and the Petition for Certiorari by Guinn, et al., followed.

SUMMARY OF THE ARGUMENT

The filing of a statutory disclaimer by a patentee of all patent claims corresponding to a count in an interference does not divest the Board of Patent Appeals and Interferences of the jurisdiction to enter a final judgment adverse to the patentee and in favor of an applicant. The Board has statutory jurisdiction of an interference despite such disclaimer.

37 C.F.R. § 1.662(c) provides that when a disclaimer by a patentee of all patent claims corresponding to a count is filed, the filing of the disclaimer will be treated as a request for entry of an adverse judgment. Contrary to Petitioners' argument, entry of the disclaimer does not

extinguish all controversy between the parties in interference because it does not, *inter alia*, resolve the issue of whether the junior party Respondent is entitled to a patent on its claims in interference. The Board therefore retains post-disclaimer jurisdiction to enter judgment in the interference.

Further, the regulation 37 C.F.R. § 1.662(c) is not inconsistent with the disclaimer statute, 35 U.S.C. § 253 because such regulation merely states how a judgment will be entered in the event a patentee exercises its right to file a disclaimer. Hence, the regulation is entirely consistent with the PTO's statutory mandate to administer the Patent Laws, and has been properly promulgated by the Commissioner of Patents and Trademarks. See, e.g., *Petrie v. Welsh*, 21 USPQ 2d 2012, 2013 (Bd. Pat. App. & Int. 1991) (interference terminated for lack of subject matter jurisdiction where patent had expired prior to declaration of the interference). See also *Perkins v. Kwon*, 886 F.2d 325, 328, 12 USPQ 2d 1308, 1311 (Fed. Cir. 1989) (Board properly decided priority issue despite determination that the invention was not patentable to one of the parties); and *United States ex rel. Newcomb Motor Co. v. Moore*, 30 D.C. App. 464, 476 (1908) (holding, in a case under former statute and not involving a disclaimer, that "the jurisdiction of the Commissioner attaches when he directs the declaration of an interference, and he still retains jurisdiction to award priority to the successful party after his adversary has been eliminated. It would indeed be an anomalous situation, if his determination that one party to an interference has no right to make the claims in issue, and therefore is not entitled to a judgment of priority, operates to deprive him of jurisdiction to award priority to the other party, who has the right to

make the claims in issue, and who is entitled to an award of priority."), *cert. denied*, 216 U.S. 608 (1910).

The Petitioners have failed to establish any conflict between the regulation, 37 C.F.R. § 1.662(c), and the statute. 37 C.F.R. § 1.662(c) therefore has the force and effect of law, *Norton v. Curtiss*, 433 F.2d 779, 791, 167 USPQ 532, 542 (CCPA 1970), and the Board properly entered judgment pursuant to 37 C.F.R. § 1.662(c).

37 C.F.R. § 1.662(c) is entirely consistent with the statutory mandate of 35 U.S.C. § 6(a) to implement the patent statute, by providing a mechanism for the Board to determine priority and patentability of inventions in interferences as required by 35 U.S.C. § 7(b). Under 35 U.S.C. § 135(a), the conditions under which an interference may be declared or initiated are specified. Section 135(a) does not limit the duration of an interference, but states, inter alia, that "*the Commisioner may* issue a patent to the applicant who is *adjudged* the prior inventor" (emphasis added). 37 C.F.R. § 1.662(c) therefore validly specifies how an interference is terminated in the case where one party statutorily disclaims all patent claims corresponding to a count.

When 37 C.F.R. § 1.662(c) was originally proposed in 1984, it did not provide for the entry of adverse judgment if a party-patentee filed a statutory disclaimer. Rather, as proposed, the rule read as follows:

> (c) The filing of a statutory disclaimer under 35 U.S.C. § 253 by a patentee will not be construed as a request for entry of an adverse judgment against the patentee, but will delete any statutorily disclaimed claims from being involved in the interference. A statutory disclaimer of any claim involved in an interference

> shall in subsequent proceedings have the same effect with respect to the patentee as an adverse judgment.

See Notice of Proposed Rulemaking, Patent Interference Proceedings, 49 Fed. Reg. 3768, 3798 (Jan. 30, 1984), *reprinted in* 1039 Off. Gaz. Pat. Office 11, 122 (Feb. 14, 1984).

In view of the comments received from the public in response to the Notice of Proposed Rulemaking, 37 C.F.R. § 1.662 was changed to its present form, providing that the filing by a patentee of a statutory disclaimer of all claims of the patent corresponding to the count will be treated as a request for adverse judgment. The reason for the change was set out in the Final Rule:

> Several comments discussing § 1.662 were received. Two comments suggested a change be made to provide that when a patentee files a statutory disclaimer under 35 U.S.C. § 253 and deletes *all* claims corresponding to a count, the disclaimer will be treated as a request for judgment. As one of the comments pointed out, "[s]ince . . . [the filing of a statutory disclaimer disclaiming all claims corresponding to a count] by the patentee could have no other conceivable effect, the proposed rule should be changed to require judgment when all corresponding claims are disclaimed." The suggestion has been adopted and appropriate changes have been made to § 1.662(c). In view of the changes, the following language in § 1.662(c), as proposed, is not necessary: "A statutory disclaimer of any claim involved in an interference shall in subsequent proceedings have the same effect with respect to the patentee as an adverse judgment."

Final Rule, Patent Interference Proceedings, 49 Fed. Reg. 48416, 48447 (Dec. 12, 1984), *reprinted in* 1050 Off. Gaz. Pat. Office 385, 416 (Jan. 29, 1985) (hereafter "Final Rule").

When the present interference rules were adopted in 1984, the Commissioner stated:

> The object of the interference will be to resolve all controversies as to all interfering subject matter defined by one or more counts. A final decision in the interference will determine who, if anyone, is entitled to claims which correspond to a count.

Final Rule at 48416, 1050 Off. Gaz. Pat. Office at 385. *See also Perkins v. Kwon*, 886 F.2d at 327-28, 12 USPQ 2d at 1310-11. The Commissioner's objective, and that of 35 U.S.C. § 135(a), to resolve all controversies would be frustrated if a patentee involved in an interference could obtain "dismissal" of the interference without judgment by filing a statutory disclaimer. To prevent such an occurrence, the Commissioner has properly exercised his rulemaking authority in promulgating 37 C.F.R. § 1.662(c), ensuring that ultimate resolution of the interference will be "final" as between the parties. The rule is not inconsistent with any statute, but rather is designed to make certain that every interference will result in a final determination of the issues involved.

In 1985, the Patent Law was amended in 35 U.S.C. § 135(a) to provide that "[t]he Board of Patent Appeals and Interferences shall determine questions of priority . . . and may determine questions of patentability."

A party during the pendency of an interference proceeding may request entry of adverse judgment at any time (37 C.F.R. § 1.601(l)). A disclaimer of all claim(s) corresponding to the count is treated as a request for entry of adverse judgment under 37 C.F.R. § 1.662(a).

The *raison d'etre* of an interference proceeding is to declare which of competing claimants is entitled to patent the subject matter (defined by the count) in controversy. Under 37 C.F.R. § 1.662(c), a party filing a disclaimer of claim(s) corresponding to the count is relinquishing the patentee's right (if any) to the subject matter in controversy. Such disclaimer has no effect on the issue of who in fact among the initial competing claimants to the subject matter of the count is the first inventor. That issue remains for the determination of the Board.

The Petitioners would have the action of filing a statutory disclaimer function to deprive the Board of Patent Appeals and Interferences of any ability to declare (by judgment) the consequences inexorably flowing from such unilateral action of a party. Simply stated, the Petitioners contend that the Board in such instance is fully deprived of the right and authority to declare judgment.

The Petitioners instead would have the power of the Board to declare judgment vanish when claims corresponding to a count are disclaimed by a party to the interference. The Board then would be powerless to award judgment and the interference proceeding would simply dissolve.

Such unilateral termination and indeterminate end of interference proceedings, however, would be wholly at

odds with the decisional scheme of administrative determination lawfully vested by statute and enabling Federal regulations in the Patent and Trademark Office Board of Patent Appeals and Interferences.

REASONS FOR DENYING THE WRIT

I. THE FEDERAL REGULATION (37 C.F.R. § 1.662(c)) ATTACKED BY PETITIONERS IS VALID AND CONSISTENT WITH TITLE 35 OF THE UNITED STATES CODE

35 U.S.C. § 7(b) provides for determination of priority and patentability of invention by the Patent and Trademark Office Board of Patent Appeals and Interferences in interferences declared under 35 U.S.C. § 135(a) between competing claimants to the same patentable invention.

Consistent therewith, the declaration by the PTO of an interference *prima facie* establishes that two or more parties claim the same patentable invention. See *Conservolite Inc. v. Widmayer,* 21 F.3d 1098 (Fed.Cir. 1994).

The preamble of 37 C.F.R. § 1.601 states that the purpose of the interference rules under the Code of Federal Regulations is "to secure the just, speedy, and inexpensive determination of every interference."

To effectuate such process, Congress has granted the Commissioner of Patents and Trademarks extremely broad powers over PTO practice. 35 U.S.C. § 6 states in part that the Commissioner "shall superintend or perform all duties required by law respecting the granting

and issuing of patents." Such power includes the discretion to promulgate regulations governing the conduct of proceedings, including interferences, before the PTO. See *Gerritsen v. Shirai*, 979 F.2d 1524 (Fed. Cir. 1992).

37 C.F.R. § 1.662(c) permits a party filing a statutory disclaimer of patent claims in an interference proceeding before the Patent and Trademark Office to thereby remove those claims from the proceeding. If all patent claims corresponding to the interference "count" that define the contested subject matter in an interference are disclaimed by a party, the disclaimer operates as a request for entry of judgment against the disclaiming party.

The Petitioners urge that 37 C.F.R. § 1.662(c) is invalid as an exercise of the Commissioner of Patents and Trademarks' power conferred by 35 U.S.C. § 6(a) to establish "regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office." Such position is based on an asserted inconsistency between 37 C.F.R. § 1.662(c) and 35 U.S.C. § 253, the latter providing that a patent holder "may, on payment of the fee required by law, make disclaimer of any complete claim" of a patent.

There is, however, no facial discord or operational incongruity between 37 C.F.R. § 1.662(c) and 35 U.S.C. § 253. The statute in § 253 is permissive of the patent holder's right to disclaim ("may . . . make disclaimer"). There is no coercion on a patent holder to take such disclaiming action, in patent interference proceedings or otherwise.

Moreover, in granting the patent holder the right to disclaim, 35 U.S.C. § 253 does not in any way limit or constrain the Commissioner of Patents and Trademarks, or the PTO, in the *procedural effect* of such disclaimer in interference proceedings involving the patent.

In application to patent interference proceedings, the grant by Congress of regulation-promulgating authority to the Commissioner of Patents and Trademarks under 35 U.S.C. § 6(a) must be read consistently with the provisions of 35 U.S.C. § 7(b), providing, in pertinent part, that:

> "[t]he Board of Patent Appeals and Interferences . . . ***shall determine*** priority and patentability of invention in interferences declared under section 135(a) of this title." (emphasis added)

Such Congressionally conferred jurisdiction of the board of Patent Appeals and Interferences is properly effectuated by relevant provisions of the Code of Federal Regulations.

37 C.F.R. § 1.606 requires, as a precedent condition of the ripeness of the priority and patentability issues to be determined by the Board between a patent application and an unexpired patent, that a Patent and Trademark Office Examiner must first establish "that there is interfering subject matter claimed in the application and the patent *which is patentable to the applicant subject to a judgment in the interference*" (emphasis added).

37 C.F.R. § 1.608(b), consistently, requires that "the [patent] applicant, before an interference will be declared, shall file evidence which may consist of patents or

printed publications, other documents, and one or more affidavits which demonstrate that applicant is *prima facie* entitled to a judgment relative to the patentee and an explanation stating with particularity the basis upon which the applicant is *prima facie* entitled to the judgment."

These regulations, 37 C.F.R. § 1.606 and 37 C.F.R. § 1.608(b), have been promulgated by the Commissioner of Patents and Trademarks as threshold requirements for commencing an interference proceeding. These regulations have not been attacked by the Petitioners as invalid or as inconsistent with statutory authority.

The Petitioners therefore appear to fully accept the precept that the Commissioner may under the provisions of 35 U.S.C. § 6(a) establish conditions for *initiating* interference proceedings. Nonetheless, Petitioners contrarily argue that the Commissioner cannot establish conditions for *procedurally concluding* interference proceedings within the statutory mandate of 35 U.S.C. § 7(b) (the Board "shall determine priority and patentability of invention in interferences") and the broad statutory permission in 35 U.S.C. § 253 (granting the patent holder the right to "make disclaimer of any complete claim" of a patent, in interference proceedings or under any other circumstances).

The Petitioners' position therefore is fundamentally at odds with the broad authority vested by 35 U.S.C. § 6(a) in the Commissioner of Patents and Trademarks to "establish regulations . . . for the conduct of proceedings in the Patent and Trademark Office."

No facial or operative inconsistency has been shown by Petitioners between 35 U.S.C. § 253 and 37 C.F.R. § 1.662(c). None exists. These statutory and regulatory provisions properly comport with the administrative rule-making power of the Commissioner conferred by Congress in 35 U.S.C. § 6(a).

II. THE PATENT AND TRADEMARK OFFICE BOARD OF PATENT APPEALS AND INTERFERENCES HAS VALID JURISDICTION TO ENTER THE JUDGMENT ATTACKED BY PETITIONERS.

35 U.S.C. § 6 grants the Commissioner of Patents and Trademarks broad jurisdiction over patent matters, stating in pertinent part that the Commissioner "shall superintend or perform all duties required by law respecting the granting and issuing of patents." 35 U.S.C. § 6(a). Congress has granted the Commissioner extremely broad powers over Patent and Trademark Office practice, which include the discretion to promulgate regulations governing the conduct of proceedings before the PTO, including interferences. See, e.g., *Gerritsen v. Shirai*, 979 F.2d 1524 (Fed. Cir. 1992).

As discussed in the preceding section of this Brief, there are operative threshold requirements under the Code of Federal Regulations for the conduct of patent interference proceedings. These jurisdictional procedural requirements include the requirement of 37 C.F.R. § 1.606 that a Patent and Trademark Office Examiner first establish "that there is interfering subject matter claimed in the application and the patent which is patentable to the applicant subject to a judgment in the interference" as

well as the requirement of 37 C.F.R. § 1.608(b) that the patent applicant "file evidence . . . and one or more affidavits which demonstrate that applicant is *prima facie* entitled to a judgment . . . and . . . the basis [therefor]."

Such requisites ensure that the Board of Patent Appeals and Interferences is jurisdictionally situated to carry out its statutory duty under 35 U.S.C. § 7(b) to "determine priority and patentability of invention in interferences."

Petitioners have argued that their disclaimer of the contested subject matter during the interference proceeding has the operative effect of depriving the Board of any jurisdictional ability to declare that Petitioners are not entitled to a patent claiming the contested subject matter they have disclaimed.

A judgment in an interference has a preclusive effect in subsequent PTO proceedings. 37 C.F.R. § 1.658(c). More specifically, a judgment in an interference settles all issues which:

(1) were raised and decided in the interference,

(2) could have been properly raised and decided in the interference by a motion under 37 C.F.R. § 1.633(a)-(d) and (f)-(j), or 37 C.F.R. § 1.634 or

(3) could have been properly raised and decided in an additional interference with a motion under § 1.633(e). *Id.*

The termination of interferences with a judgment achieves administrative decisional economy, permitting conclusive determination of issues susceptible of resolution in an interference forum.

It is in the PTO's interest and in the public interest that a determination of priority and patentability of invention is final and conclusive in every interference proceeding. If adverse judgments were prevented from being entered in interference proceedings under the provisions of 37 C.F.R. § 1.662(c), patent holders might otherwise be motivated to reinitiate interference proceedings, relitigate issues currently committed to the decisional role of the Board for final determination, and/or unilaterally withdraw from interference proceedings upon anticipation of a possible negative outcome, to avoid the fact and consequence of a disfavorable judgment.

III. PETITIONERS HAVE GROSSLY MISCHARACTERIZED THE PROCEEDINGS BEFORE THE PATENT AND TRADEMARK OFFICE, BY ARGUING THE ABSENCE OF A RECORD OF PATENTABILITY DETERMINATION; THERE IS SUCH A RECORD, AND PETITIONERS ACTIVELY PARTICIPATED IN MAKING IT

The Petitioners have argued, as a predicate for their attack on the Board's decision for which they seek review, that *"no issues of patentability of the involved application claims* [of Respondent's patent applications] *have been fully developed on the record of the interference* before the Board of Patent Appeals and Interferences" (emphasis added; Petition, page (i)).

The Petitioners therefore challenge the ability of the Board to hold that Respondent is entitled to a patent on the patent application claims in the interference, *"in the absence of a record"* (emphasis added; Petition, page (i)).

The crux of the Petitioners' case – depending on which portion of the Petition's Question 3 ("Questions Presented" at page (i) of the Petition) receives attention – is either that "no issues of patentability [of Respondent's claims] have been fully developed on the record of the interference," or that the Board's holding of Respondent's entitlement to patent the subject matter in interference was made "in absence of a record." Regardless of which of these "no record" and "no fully developed record" characterizations is examined, the Petitioners' contention of inadequacy of the record of patentability does not survive close scrutiny.

As mentioned in the preceding section of this Brief, 37 C.F.R. § 1.606 requires that for interference proceedings to commence between a patent application and an issued patent, a Patent and Trademark Office Examiner must first establish "that there is interfering subject matter claimed in the application and the patent which is patentable to the applicant subject to a judgment in the interference."

37 C.F.R. § 1.608(b) additionally requires a *prima facie* showing by a patent applicant as a threshold requirement for an interference proceeding, *viz.*, that the patent applicant "file evidence . . . and one or more affidavits which demonstrate that applicant is *prima facie* entitled to a judgment . . . and . . . the basis [therefor]."

These events must occur in the Patent and Trademark Office before a patent interference proceeding can begin. These events require evidence, *on the record,* for each patent application that is involved in the interference proceeding.

In the interference here involved, the Examiner charged with the responsibility of determining contingent patentability (subject to the final decision in the interference) of the claims in Respondent's patent applications had rigorously examined such applications. The Examiner had considered prior art and arguments for patentability of the Respondent's claims, and the Examiner had concluded that the Respondent's applications containing such claims were of appropriate form for the interference proceeding.

On October 9, 1992, the Examiner issued a communication in each of Respondent's involved applications – Paper No. 18 in Respondent's U.S. Patent Application No. 07/442,240, and Paper No. 10 in Respondent's U.S. Patent Application No. 07/207,655 – copies of which are attached in Appendices A and B of this Brief, respectively. In such communications, the Examiner, stating that "[a]pplicant must fully comply with 37 C.F.R. 1.608(b)," required affidavit evidence and "an explanation stating with particularity the basis upon which the applicant would be *prima facie* entitled to the judgment" in an interference with the Guinn, et al. (Petitioners') patent.

On the basis of the resulting record in the Patent and Trademark Office proceedings, an interference was declared, in which Petitioners subsequently took a full and active part. It is noted here that Petitioners have not complained of being foreclosed from participation in the interference proceeding. They have not expressed concern that their due process rights of involvement in the interference were truncated. Petitioners have argued

simply that the Board did not have an appropriate record of patentability of the Respondent's patent application claims, on which to base a decision in the interference.

This position is taken by Petitioners, despite the fact that Petitioners are not contesting the rigor or propriety of the patentability determination made by the Examiner *in which the Examiner concluded, consistent with the requirements of 37 C.F.R. § 1.606, that the interfering subject matter claimed by Respondent is prospectively patentable to the Respondent subject to a final decision in the interference proceeding.*

Accordingly, the Petitioners' position stands or falls on the simple issue of the adequacy of the record of patentability of Respondent's claims before the Board of Patent Appeals and Interferences.

An interference proceeding accommodates a variety of motions during the so-called "motion period" of the interference process. The motions which can be filed by a party to an interference include motions under 37 C.F.R. § 1.633(a). 37 C.F.R. § 1.633(a) specifically permits a party to file a preliminary motion in the interference proceeding, attacking the patentability of an opponent's patent claim:

"§ 1.633 Preliminary motions.

A party may file the following preliminary motions:

(a) A motion for judgment against an opponent's claim designated to correspond to a count on the ground that the claim is not patentable to the opponent. The motion shall separately address each claim alleged

> to be unpatentable. In deciding an issue raised in a motion filed under this paragraph (a), a claim will be construed in light of the specification of the application or patent in which it appears."

In the interference here involved, a Motion for Judgment Pursuant to 37 C.F.R. § 1.633 was filed in the interference by the Petitioners on May 17, 1993 (Paper No. 11 of the interference), with which references A-H were submitted to the Board by Petitioners. The Motion contained arguments that the cited references anticipated under 35 U.S.C. § 102, or rendered obvious under 35 U.S.C. § 103, the claims of Respondent's patent applications corresponding to the count defining the contested subject matter of the interference.

Petitioners also filed a subsequent Motion for Judgment in the interference (Paper No. 21), again urging that the claims of Respondent's applications in the interference were anticipated under 35 U.S.C. § 102 or rendered obvious under 35 U.S.C. § 103.

The Board's Decision on Motions issued on September 29, 1994. The first Motion (Paper No. 11) was denied, and the second Motion (Paper No. 21) was dismissed. In the "Decision on Motions," the references cited by the Petitioners were discussed by the Board.

The Board, in its consideration of the references adduced by the Petitioners, did not determine any substantive basis for holding Respondent's claims invalid. The Petitioners had opportunity to be heard in the interference proceeding, and to present evidence on the issue

of patentability of the Respondent's claims involved in the interference.

The Petitioners therefore actively participated in the proceedings before the Board, and they introduced references urged by them to invalidate the Respondent's patent application claims. The Petitioners' motions filed in the interference proceedings were decided favorably to the patentability of Respondent's claims.

Petitioners now take issue with the Board's judgment in favor of Respondent, and variously argue "the absence of a record" and, curiously and inconsistently, that "no issues of patentability have been fully developed on the record of the interference."

The Petitioners therefore seek by vague allegations of an inchoate record – allegations fully rebutted by the record of Petitioners' involvement in the interference proceeding before the Board – to defeat the Board's judgment by collateral attack on the validity of 37 C.F.R. § 1.662(c).

In fact, the Petitioners in their attempt to have this Court invalidate 37 C.F.R. § 1.662(c) are simply seeking to evade the direct and logical consequence of their own action in disclaiming the subject matter in controversy. That consequence is the Board's judgment against Petitioners, and that judgment is mandated by 35 U.S.C. § 7(b)'s statutory directive to the Board to "determine priority and patentability . . . in interferences."

No basis exists for reversible error in the decision of the Board or in the decision of the United States Court of Appeals for the Federal Circuit affirming the Board's decision.

It therefore is requested that the Petition be denied, so that the Board's decision in the matter is finally effectuated, to permit patents to issue on Respondent's long-pending applications involved in the interference.

CONCLUSION

The Petitioners have grossly mischaracterized the record, in attacking the validity of 37 C.F.R. § 1.662(c) governing the termination of interference proceedings between competing claimants to patentable subject matter in the instance where one party files a terminal disclaimer of all claims corresponding to the count in the patent interference.

The Petitioners have in fact totally ignored the record and the provision of 37 C.F.R. § 1.606 requiring the PTO to determine before an interference is declared that the interfering subject matter of a patent application is patentable to the applicant subject to a judgment in the interference.

The Petitioners also have ignored the procedural provisions of C.F.R. § 1.608 which require an applicant for patent, prior to the declaration of an interference, to file evidence demonstrating that applicant is *prima facie* entitled to judgment relative to the patentee, with an explanation of the particular basis on which applicant is *prima facie* entitled to the judgment (as was done before the U.S. Patent and Trademark Office prior to the initiation of the interference here involved).

Finally, the Petitioners have mischaracterized the record as being devoid of any prior art determination, despite the fact that Petitioners filed Motions for Judgment pursuant to 37 C.F.R. § 1.633(a) in the interference, seeking judgment of unpatentability of Kopf's claims on prior art grounds. The Petitioners therefore seek review by this Court based on their allegations of the lack of a record of patentability determination before the Board, an assertion which is false and inconsistent with the record of this case.

When a patent holder involved in an interference proceeding exercises his right under 35 U.S.C. § 253 to disclaim all involved claims corresponding to the count, he has unequivocally waived his rights to the subject matter of the count. 37 C.F.R. § 1.662(c) merely states the direct and inescapable result of the patentee's action in providing that a disclaimer of all of a patent's involved claims corresponding to a count shall be treated as a request for adverse judgment.

Under 35 U.S.C. § 7, the Board of Patent Appeals and Interferences is vested with authority to receive evidence and determine issues of priority and patentability, and to determine, *inter alia*, any issue of interference in fact as to any count, and any other issue necessary to resolve the interference.

It is fundamental to the governmental processes of an orderly society that the jurisdiction of a tribunal, whether judicial or administrative, be committed in the scheme of governance to achieve final and dispositive results. This objective requires the tribunal to declare a result binding

the parties and resolving the controversy. Were it otherwise, parties could simply unilaterally declare the absence of power and authority binding them at any stage of the proceedings, and withdraw from the matter in controversy, consistent with the intention not to be bound.

That, simply stated, is what Petititoners seek. The Petitioners were under no compulsion to file the disclaimer of the claim in interference. If the Petitioners thought themselves unworthy of receiving adverse judgment, they could have remained and fully and fairly argued their position on the merits to an intended successful conclusion.

The Petitioners now seek by vague allegations of an inchoate patentability record – an allegation which is fully rebutted by the substantive and procedural events involved in this matter – to mount an attack on the validity of 37 C.F.R. § 1.662(c).

By this tactic, the Petitioners seek to evade the just and logical consequence of their own action in disclaiming the subject matter in controversy, namely, a judgment based on the action that Petitioners have taken.

For all these reasons, it is requested that Guinn, et al's Petition for Writ for Certiorari be denied.

Respectfully submitted,

STEVEN J. HULTQUIST
Counsel of Record for Respondent
INTELLECTUAL PROPERTY/TECHNOLOGY LAW
200 Park Offices Drive, Suite 210
Research Triangle Park, NC 27709
Telephone: (919) 990-9531

Appendix A – October 9, 1992 Communication from Supervisory Primary Examiner James C. Housel of Group 180 of U.S. Patent and Trademark Office in U.S. Patent Application No. 07/442,240 of Henry B. Kopf (Paper No. 18)

APPENDIX A

[SEAL]

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER
07/442,240

FILING DATE
11/28/89

FIRST NAMED APPLICANT
KOPF H

ATTORNEY DOCKET NO.
KOHB5022P

STEVEN J. HULTQUIST
INTECLLECTUAL [sic]
PROPERTY/TECHNOLOGY LAW
P O BOX 14329
RESEARCH TRIANGLE PARK, NC
27709

EXAMINER
HOUSEL, J

ART UNIT
1809

PAPER NUMBER
18

DATED MAILED:
10/09/92

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE ONE MONTH~~S, DAYS~~ FROM THE DATE OF THIS LETTER.

Applicant is advised, as per the previous Interview Summary Record, that an interference has proposed between the instant application and Guinn et al., U.S. Patent 4,889,812. Since the effective filing date of the instant application is more than three months after the filing date of the Guinn et al. patent, Applicant must fully comply with 37 CFR 1.608(b). While the affidavit filed 4/18/91 under 37 CFR 1.131 may be intended to comply with the rule, §1.608(b) further requires:

> (1) affidavits by one or more corroborating witnesses, i.e., witnesses other than the applicant; with each affidavit setting out a factual description of acts and circumstances performed or observed by the affiant, and
>
> (2) an explanation stating with particularity the basis upon which the applicant would be *prima facie* entitled to the judgment.

Applicant is therefore required to furnish the above-noted documentation before an interference can be declared. Failure to timely submit the above-noted documentation in compliance with 37 CFR 1.608(b) will result in abandonment of the instant application. Extensions of time for the filing of the response may be obtained in accordance with 37 CFR 1.136(a).

/s/ James C. Housel 10/9/92

JAMES C. HOUSEL
SUPERVISORY PATENT
EXAMINER
GROUP 180

Appendix B – October 9, 1992 Communication from Supervisory Primary Examiner James C. Housel of Group 180 of U.S. Patent and Trademark Office in U.S. Patent Application No. 07/207,655 of Henry B. Kopf (Paper No. 10)

APPENDIX B

[SEAL]

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER
07/207,655

FILING DATE
06/21/88

FIRST NAMED APPLICANT
KOPF H

ATTORNEY DOCKET NO.
5005P

STEVEN J. HULTQUIST
HARLOW, REILLY, DEER,
& STARK
1000 PARK FORTY PLAZA
P.O. DRAWER 13448
RESEARCH TRIANGLE PARK, NC
27709

EXAMINER
HOUSEL, J

ART UNIT
1809

PAPER NUMBER
10

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Commissioner of Patents.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE ONE MONTH~~S, DAYS~~ FROM THE DATE OF THIS LETTER.

Applicant is advised, as per the previous Interview Summary Record, that an interference has proposed between the instant application and Guinn et al., U.S. Patent 4,889,812. Since the effective filing date of the instant application is more than three months after the filing date of the Guinn et al. patent, Applicant must fully comply with 37 CFR 1.608(b). While the affidavit filed 4/18/91 under 37 CFR 1.131 may be intended to comply with the rule, §1.608(b) further requires:

> (1) affidavits by one or more corroborating witnesses, i.e., witnesses other than the applicant; with each affidavit setting out a factual description of acts and circumstances performed or observed by the affiant, and
>
> (2) an explanation stating with particularity the basis upon which the applicant would be *prima facie* entitled to the judgment.

Applicant is therefore required to furnish the above-noted documentation before an interference can be declared. Failure to timely submit the above-noted documentation in compliance with 37 CFR 1.608(b) will result in abandonment of the instant application. Extensions of time for the filing of the response may be obtained in accordance with 37 CFR 1.136(a).

/s/ James C. Housel 10/9/92

JAMES C. HOUSEL
SUPERVISORY PATENT
EXAMINER
GROUP 180

(3)

No. 96-1271

Supreme Court, U.S.
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IN THE
Supreme Court of the United States
OCTOBER TERM, 1996

PERRY W. GUINN, GARY N. MILLS,
ROBERT A. BEDIENT and MARTIN O. GREELEY,
Petitioners,

v.

HENRY B. KOPF,
Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

---

PETITIONERS' REPLY BRIEF

EDWARD S. IRONS
555 Thirteenth Street, N.W.
Suite 701—East Tower
Washington, D.C. 20004
Phone: (202) 626-3564
Attorney for Petitioners

WILSON - EPES PRINTING CO., INC. - 789-0096 - WASHINGTON, D.C. 20001

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PETITIONERS' REPLY BRIEF

QUESTION 1

1. Question 1 ("Is 37 C.F.R. § 1.662(c) invalid under 35 U.S.C. § 6(a) because it is 'inconsistent with' 35 U.S.C. § 253") requires determination of the scope of 35 U.S.C. § 253.

> "In determining the scope of a statute, we look first to its language. If the statutory language is unambiguous, in the absence of a 'clearly expressed legislative intent to the contrary, that language must ordinarily be regarded as conclusive.'" . . . [Citations omitted.]

Reves v. Ernst & Young, 507 U.S. 170, 176, 113 S.Ct. 1163, 1169 (1993).

The unambigous statutory language of 35 U.S.C. § 253 states:

> Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim. . . .

"[T]he broadest of the PTO's rulemaking powers—35 U.S.C. § 6(a)—authorizes the Commissioner to promulgate regulations directed only to 'the conduct of proceedings in the [PTO]'; it does *not* grant the Commissioner the authority to issue substantive rules", *Merck & Co. v. Kessler*, 80 F.3d 1543, 1549-1550, 38 USPQ2d 1347, 1351 (Fed. Cir. 1996), emphasis in original, citing and quoting *Animal Legal Defense Fund v. Quigg*, 932 F.2d 920, 930 (Fed. Cir. 1991) (citations in footnote 6 omitted).

Under *Reves* and *Merck*, the Commissioner's promulgation of 37 C.F.R. § 1.662(c) was *not authorized* for each of two dispositive reasons:

(i) 37 C.F.R. § 1.662(c) is "inconsistent", 35 U.S.C. § 6(a), with 35 U.S.C. § 253 because it imposes a limitation upon the statute *which Congress did not express.*[1]

(ii) 37 C.F.R. § 1.662(c) is therefore a "substantive rule[]" which, under *Merck*, 35 U.S.C. § 6(a) "does *not*" authorize the Commissioner "to issue".

The limitation incorrectly imposed on 35 U.S.C. § 253 by 37 C.F.R. § 1.662(c) is emphasized in the following combined reproduction of the statute and the rule:

> A patentee . . . may, on payment of the fee required by law, make disclaimer of any complete claim, . . . [*provided, however, if the patentee is involved in an interference, the disclaimer shall constitute a request*

---

[1] *Cf., Diamond v. Chakrabarty*, "[w]e have . . . cautioned that courts 'should not read into the patent laws limitations and conditions which the legislature has not expressed' ", 447 U.S. 303, 308, 100 S.Ct. 2204, 2007 (1980), quoting from *United States v. Dubilier Condenser Corp.*, 289 U.S. 178, 199, 53 S.Ct. 554, 561 (1933).

for adverse judgment if it results in the deletion of all patent claims corresponding to the count].

Under 37 C.F.R. § 1.658(a), an "adverse judgment" entered pursuant to 37 C.F.R. § 1.662(c) "shall state whether or not [*the party opposing the disclaiming patentee*] is entitled to a patent containing the claims in [that] party's . . . application which correspond to the count".[2]

37 C.F.R. § 1.662(c) fundamentlly changes and was intended by the Commissioner to fundamentally change the law as it had existed from 1952 to 1984 regarding patent interferences instituted under 35 U.S.C. § 135(a). The Petition explains that:

> Under the 1952 Act, interferences involving an application and a patent were routinely *dissolved without a judgment* if the patentee filed a statutory disclaimer pursuant to 35 U.S.C. § 253 (1952) of the involved patent claim (count). This dissolution by disclaimer and without a judgment practice is set forth in the authoritative treatise Rivise and Caeser *Interference Law and Practice*, Vol. II, § 317:
>
> > An interference may be terminated by dissolution on one or more of the following grounds:
> >
> > * * * *
> >
> > (3) In an interference involving an application and a patent, that the patentee has eliminated the conflicting subject matter by means of a reissue *or statutory disclaimer*.

---

[2] Claims which "correspond" to the count are for subject matter *different* from the count *unless* designated to "correspond *exactly*". See 37 C.F.R. § 1.601(f).

The Board, instructed by 37 C.F.R. § 1.662(c), treated the Guinn disclaimer as a "request for entry of judgment". 37 C.F.R. § 1.658 required the judgment to state whether Kopf "is entitled to a patent containing the [30] claims in [Kopf's] applications which correspond to [but are not identical to Guinn claim 9]. . . . (Pet. at 6).

No Kopf claim is said by the Board or the Court to correspond "exactly" to claim 9 of Guinn's patent which was disclaimed.

and § 334:

> We have seen that a patentee involved in an interference may bring about a dissolution of the interference *by filing a statutory disclaimer* elim*inating* or substantially modifying the claims of his patent corresponding to the issue of the interference. . . .
>
> * * * *
>
> As has been stated, a patentee, who wishes to terminate an interference by disclaimer, has his choice between a statutory disclaimer and a disclaimer under Rule 107. *A statutory disclaimer is preferable, as it may result in a dissolution of the interference rather than in an adverse judgment.* [Emphasis added.]
>
> In 1984, 35 U.S.C. § 135(a) was amended to supplement the Board's *mandatory* jurisdiction to determine the question of *priority* by adding *discretionary jurisdiction* to determine "questions of *patentability*".
>
> * * * *
>
> After the amendment, the Commissioner promulgated Rules 1.662(c) and 1.658, purportedly under 35 U.S.C. § 6, to *eliminate* the disclaimer-dissolution without a judgment practice routine under the 1952 Act. (Pet. at 7-8; footnote omitted)

Question 1 requires the Court to determine the validity of the Commissioner's deliberate repudiation, by substantive rulemaking not authorized by 35 U.S.C. § 6(a), of the disclaimer law set forth in 35 U.S.C. §§ 135(a) and 253 as it had been applied for more than 30 years from 1952 to 1984.

2. The Opposition to the Petition advances misdirected arguments based on the 1984 amendments to 35 U.S.C. §§ 7(b) and 135(a). The Federal Circuit considered these amendments in 1989, however. Its decision at that time shows these arguments largely to be frivolous. Pointedly, the Federal Circuit's decision in this 1996 case

does not even mention 35 U.S.C. § 7(b) (1984)—now the centerpiece of the respondent's case.

(i) In *Perkins v. Kwon*, 886 F.2d 325, 326, 12 USPQ2d 1308, 1309 (Fed. Cir. 1989), the "issue" before the Federal Circuit was "whether it was appropriate for the Board to determine priority of invention in the interference, and to enforce the consequences thereof against Perkins, when the Board held that the count was not patentable to Kwon, a party to the interference". The Court ruled in the affirmative, but *only* "if patentability is fairly placed at issue in the proceeding" and "had been adduced [on] an appropriate record". 886 F.2d at 328. As a predicate for its ruling, the Federal Circuit stated:

> This issue arises out of the consolidation of the two tribunals within the Patent and Trademark Office that had previously dealt separately with patentability (the Board of Appeals) and with priority (the Board of Patent Interferences), and the accompanying changes in interference practice. The statute that created the consolidated Board includes the provision, at 35 U.S.C. § 7(b):
>
> > The Board of Patent Appeals and Interferences shall . . . determine priority and patentability of invention in interferences declared under section 135(a) of this title.
>
> 35 U.S.C. § 135(a) was concurrently amended to include the provision:
>
> > The Board of Patent Appeals and Interferences shall determine questions of priority of the inventions and may determine questions of patentability.
>
> Patent Law Amendments Act of 1984, Pub.L.No. 98-622, §§ 201-207, 98 Stat. 3383, 3386-89 (1984), enacted November 8, 1984.
>
> * * * *
>
> We agree with the Board that issues of patentability and priority *that have been fully developed before the Board should be resolved by the Board.*

Kwon v. Perkins, 6 USPQ2d at 1750. The Commissioner also states that although the Board is authorized to decide the issues of both priority and patentability under circumstances such as those of this case, it is discretionary with the Board as to whether it will resolve questions of patentability that arise during an interference proceeding, referring to the term "may" in the statute:

> 35 USC § 135(a). . . . The Board of Patent Appeals and Interferences shall determine questions of priority of the inventions and may determine questions of patentability. . . .

The legislative history, however, shows that Congress intended that if patentability is fairly placed at issue in the proceeding, it will be determined. . . . The word "may" in § 135(a) accommodates the situation when patentability is not placed at issue during the priority contest, but it would contradict the remedial purpose of the legislation if the Board could refuse to decide questions of patentability *for which there had been adduced an appropriate record* . . . .

It would similarly contradict the legislative purpose if the Board were to refrain from deciding priority, when the result of such restraint would be the issuance or preservation of a facially invalid patent. . . .

886 F.2d 326, 328 (emphasis added).

(ii) The Opposition apparently construes 35 U.S.C. § 7(b)'s statement that "[t]he Board of Patent Appeals and Interferences *shall* . . . determine priority and patentability of invention" to preclude a disclaimer under § 253 of a patentee's only claim involved in an interference (here Guinn's patent claim 9) in order to somehow preserve an issue of patentability or priority for the Board to "determine". See R. Br. 10. The argument is frivolous.

(iii) The same "shall . . . determine priority and patentability" phrase from 35 U.S.C. § 7(b) apparently is relied upon to insist—again frivolously in the Opposi-

tion—that the Board is vested with jurisdiction to determine a *moot* question of *priority* where, as here, the patentee party to an interference has disclaimed the *only* claim in the patent under 35 U.S.C. § 253 *before the judgment was entered.* See Question 2 and the Petition at 12. *Per contra,* for lack of any justiciable controversy *after* the disclaimer, even Congress is precluded from purporting to authorize the Board to "determine" the moot priority issue.

QUESTION 3

Guided by the Federal Circuit's admonition in *Perkins* (Board authority to decide patentability requires fully developed record before it), Question 3 raises the issue of whether the Board has power or could have been empowered by Congress to adjudicate the question of patentability in the absence of an appropriate patentability record. Despite the fact that the Federal Circuit in *Perkins* affirmatively indicated that the Board had no such jurisdiction, the same Court's decision in this case holds to the contrary ("[w]e affirm the Board's judgment . . . against Guinn" (Pet. at 8a) "that Kopf was entitled to a patent containing claims 19-31 in application Serial No. 07/442,240, and a patent containing claims 20-38 in application Serial No. 07/207,655. . ." (Pet. at 1a-2a). Review is appropriate not only to resolve this conflict in the Federal Circuit's decisions but also to insure that patentability judgments are supported by evidence.

Section III at pp. 14-20 and the Conclusion at pp. 20-22 of respondent's Opposition urge denial of this Petition on the basis of unfounded and unprofessional charges that it lacks candor as to Question 3 issues.[3] To expose the

[3] E.g., "[t]he Petitioners have grossly mischaracterized the record. . ." (R. Br. 20); "Petitioners have mischaracterized the record. . ." (R. Br. 21); and "Petitioners . . . seek review by this Court based on . . . an assertion which is false and inconsistent with the record of this case" (R. Br. 21).

These charges are all based on the respondent counsel's testimony setting forth his version of the facts and upon documents not

fallacy of that charge, the *actual* basis—which is devoid of any patentability issue—for decision by the Patent Office Board and therefore of the Federal Circuit's affirmance is set forth below.

THE BOARD OPINION

The Board decision (included in the Appendix to Petitioner's brief below at A1-A7) appears in the Petition at Appendix B, 9a-14a. It states:

> On October 13, 1994, Guinn filed a statutory disclaimer of its sole involved claim (claim 9). Accordingly, the Administrative Patent Judge (APJ) issued an order to show cause against Guinn (Paper No. 43), indicating that the statutory disclaimer will be treated as a request for entry of an adverse judgment against Guinn pursuant to 37 CFR 1.662(c). Guinn has filed a response to the order to show cause (Paper No. 45), and Kopf has filed a response to that of Guinn (Paper No. 46).
>
> In their respective responses, neither party has requested that a final hearing or a testimony period be set with respect to the propriety of the show cause order. Rather, the Guinn response contains a discussion of reasons why Guinn believes that the rule, § 1.662(c), is "facially invalid" and that the Board therefore lacks jurisdiction to enter judgment against Guinn in view of Guinn's filing of a statutory disclaimer.
>
> As set forth in the Commissioner's Notice entitled *"Interference Practice: Response to Order to Show Cause under 37 CFR 1.640,"* 1074 O.G. 4 (Jan. 6, 1987), where the response does not request a final hearing or a testimony period but, instead, contains a full discussion of the reasons why judgment should not be entered, the response paper is deemed to waive "any opportunity to present oral argument concern-

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included in the appendix to respondent's brief before the Federal Circuit. See R. Br. App. A and B and text at pp. 15-19.

ing the matters discussed therein, and the matter will be decided by the Board based upon the content of the paper and any response thereto." *Qadri v. Chu,* 18 USPQ2d 1254 (BPAI 1990), *aff'd mem.,* 965 F.2d 1063 (Fed. Cir. 1992); *Brown v. Bravet,* 25 USPQ2d 1147 (BPAI 1992). *Accordingly, we will decide the matter discussed by the parties in their respective responses based upon the arguments presented therein.*

* * * *

Judgment

* * * *

Henry B. Kopf is entitled to a patent containing his involved claims 19-31 in application Serial No. 07/442,240, and is also entitled to a patent containing his involved claims 20-38 in application Serial No. 07/207,655, provided that Kopf takes the action which is necessary to avoid a double patenting rejection, e.g., by filing a terminal disclaimer in one of his involved applications, when *ex parte* prosecution resumes upon termination of this interference. Perry W. Guinn, Gary N. Mills, Robert A. Bedient and Martin O. Greeley, the senior party patentees, are not entitled to a patent containing their involved claim 9 which has been disclaimed under 35 U.S.C. 253. (App. 11a-14a; emphasis added)

The important point here is that the board based its decision solely on the arguments of the parties in their "responses" to the show cause order—not on any patentability record whatsoever, "fully developed" or otherwise.

The Federal Circuit—affirming the Board—perforce based its decision *as the Board had done* solely on the parties' responses to the show cause order. See the Petition at 3a-4a (referring to the responses to the show cause order).

Acknowledging the *lack* of any "patentability record" basis for the Board's decision, the Federal Circuit correctly held: "*The patentability of Kopf's claims corre-*

sponding to the count is beyond the scope of this appeal" [4] (Pet. at 8a). Nevertheless, in conflict with its prior decision in *Perkins*, the Federal Circuit surprisingly "AFFIRMED" (Pet. at 8a) the "Board's judgment" quoted *supra*, p. 9 that Kopf is entitled to patents containing 30 claims from his involved applications.

CONCLUSION

The Petition should be granted.

Respectfully submitted,

EDWARD S. IRONS
555 Thirteenth Street, N.W.
Suite 701—East Tower
Washington, D.C. 20004
Phone: (202) 626-3564
Attorney for Petitioners

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[4] In this way, the Federal Circuit evaded a decision of the issue that was squarely presented to it, namely whether the Board had jurisdiction to render a patentability judgment.